

**REMARKS**

The final Office Action of November 20, 2007, has been received and reviewed.

The withdrawal of rejections based on den Hamer is noted with appreciation.

Claims 1, 2, 4-10, 18, and 19 are currently pending and under consideration in the above-referenced application, each standing rejected.

Reconsideration of the above-referenced application is respectfully requested.

**Rejections under 35 U.S.C. § 102**

Claims 1, 2, 4-10, 18, and 19 stand rejected under 35 U.S.C. § 102(b).

A claim is anticipated only if each and every element, as set forth in the claim, is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Mark

Claims 1, 2, 4, 5, 8, 9, 18, and 19 have been rejected under 35 U.S.C. § 102(b) for reciting subject matter which is purportedly anticipated by the subject matter described in U.S. Patent 6,238,120 to Mark (hereinafter “Mark”).

Mark describes a system for dispensing small amounts of fluid. Col. 1, lines 5-7. The system of Mark includes a fluid reservoir 23, 40, 41 with a female coupling element at one end thereof. The female coupling element is configured to receive and couple to a male coupling element of a fluid applicator 10. The opposite end of the fluid applicator 10 includes an elongate extension 17 with flocked ball 20 at the tip thereof. Upon reducing a volume of the reservoir 23, 40, 41, fluid is forced through the elongate extension 17 of the fluid applicator 10 and onto the flocked ball 20. *See, e.g.*, Col. 2, lines 27-30; col. 3, lines 15-16.

It is respectfully submitted that Mark does not expressly or inherently describe several elements of the hand-held pick and place apparatus of independent claim 1. For example, Mark does not expressly or inherently describe “a grasping element including an end for adhesion to a

piece to be picked...” Rather than describing that fluid of the disclosed system may be used to adhere to “a piece to be picked,” Mark describes a system for applying small amounts of fluid to objects.

Further, Mark includes no express or inherent description that the grasping element may adhere to “a piece to be picked while leaving substantially no residue on the piece...” Instead, the description of Mark is limited to a system for applying small amounts of fluid. When the system of Mark is used, the small amount of fluid, which certainly qualifies as a residue, will remain on the object to which the fluid has been applied.

In addition, the system of Mark lacks a tip that, when rotated relative to a body (*e.g.*, the reservoir 23, 40, 41), will define “a position of the end for adhesion of the grasping element relative to a free end of the tip.” The description of Mark is instead limited to a fluid applicator 10 with a male element that is either not coupled to the female element of a reservoir 23, 40, 41, or that is fully coupled to (*i.e.*, completely screwed into) the female element of the reservoir 23, 40, 41.

In view of the foregoing, it is respectfully submitted that Mark does not anticipate each and every element of independent claim 1, as would be required to maintain the 35 U.S.C. § 102(b) rejection of independent claim 1.

Claims 2, 4, 5, 8, and 9 are each allowable, among other reasons, for depending directly or indirectly from independent claim 1, which is allowable.

With respect to the subject matter recited in independent claim 18, it is respectfully submitted that the fluid application system of Mark lacks a grasping element.

Additionally, Mark lacks any express or inherent description of a body-engagement element that is “configured... to be rotated relative to [a] body [of a pick-and-place apparatus] so as to cause the grasping element to be extruded from the tip or retracted therein.” The only purpose for rotating the fluid applicator 10 of the fluid application system of Mark relative to the reservoir 23, 40, 41 of that fluid application system is to secure the fluid applicator 10 to the reservoir 23, 40, 41. The only ways that fluid may be forced through the fluid applicator 10 that

are described in Mark are by forcing a plunger 25 through the barrel 23 of a syringe, or by squeezing a reservoir 41 like an eye dropper. Col. 2, lines 27-30; col. 3, lines 15-16.

Thus, Mark does not anticipate each and every element of independent claim 18, as would be required to maintain the 35 U.S.C. § 102(b) rejection of independent claim 18.

Claim 19 is allowable, among other reasons, for depending directly from independent claim 18, which is allowable.

Seymour

Claims 1, 2, 4-10, 18, and 19 are rejected under 35 U.S.C. § 102(b) for being drawn to subject matter that is allegedly anticipated by the subject matter described in U.S. Patent 6,293,431 to Seymour et al. (hereinafter “Seymour”).

Seymour describes a container 2, an elongate part 5 that includes an outlet channel 3 and that may be coupled to an opening of the container 2, an annular part 4 that couples the elongate part 5 to the opening of the container 2, and a closure cap 15 that is configured to be positioned over the elongate part 5 and coupled to the annular part 4 to seal the container 2 once the contents of the container 2 have been exposed through the outlet channel 3 of the elongate part. The closure cap 15 may include a piercing member 16 that, when the closure cap 15 is first disposed over the elongate part 5, pierces a membrane at an end of the elongate part 5 to open the outlet channel 3 and, thus, to enable extrusion of the contents of the container 2 through the outlet channel 3. Once the membrane of the elongate part 5 has been pierced, extrusion of the container 2's contents may be prevented (*i.e.*, the container 2 may be sealed) by recoupling the closure cap 15 and the annular part 4.

Like the system of Mark, the apparatus of Seymour merely dispenses fluids. Although those fluids may include adhesive materials, Seymour provides no express or inherent description that the container may hold “a grasping element including an end for adhesion to a piece to be picked...” Instead of being used to adhere to objects, the fluid within the apparatus of Seymour is configured to be applied to objects.

Nor does Seymour expressly or inherently describe a grasping element that will leave “substantially no residue on the piece.” Rather, when an adhesive is dispensed from the

container of Seymour and onto an object, a residue of the adhesive material will certainly remain on the object.

Seymour also lacks any express or inherent description of the manner in which fluid is extruded from the container 2. More specifically, Seymour does not expressly or inherently describe that rotation of the elongate part 5 relative to the container 2 “define[s] a position of [an] end for adhesion of [a] grasping element relative to a free end of the tip” of the elongate part 5. Independent claim 1. It is instead presumed that fluid is removed from the container 2 by squeezing the container 2 or by use of a piston to force fluid from the container. *See, e.g.*, col. 1, lines 16-20.

Therefore, it is respectfully submitted that Seymour does not anticipate each and every element of independent claim 1, as would be required to maintain the 35 U.S.C. § 102(b) rejection of independent claim 1.

Each of claims 2 and 4-10 is allowable, among other reasons, for depending directly or indirectly from independent claim 1, which is allowable.

Independent claim 18 is allowable since Seymour includes no express or inherent description that the disclosed system includes a grasping element or a body-engagement element that is “configured... to be rotated relative to [a] body [of a pick-and-place apparatus] so as to cause the grasping element to be extruded from the tip or retracted therein.” The only apparent reason to rotate the elongate part 5 of the system of Seymour relative to the container 2 is to secure the elongate part 5 to the container. Thus, Seymour does not anticipate each and every element of independent claim 18, as would be required to maintain the 35 U.S.C. § 102(b) rejection of independent claim 18.

Claim 19 is allowable, among other reasons, for depending directly from independent claim 18, which is allowable.

Withdrawal of the 35 U.S.C. § 102(b) rejections of claims 1, 2, 4-10, 18, and 19 is respectfully solicited, as is the allowance of each of these claims.

**Rejections under 35 U.S.C. § 103(a)**

Claims 6, 7, and 10 stand rejected under 35 U.S.C. § 103(a) for reciting subject matter which is assertedly unpatentable over that taught in Mark, in view of teachings from U.S. Patent 5,388,726 to Otake (hereinafter "Otake").

Claims 6, 7, and 10 are each allowable, among other reasons, for depending directly or indirectly from independent claim 1, which is allowable.

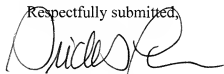
Claim 7 is further allowable since neither Mark nor Otake teaches or suggests a cap that is configured to rotate a tip when the cap is secured to the tip.

Withdrawal of the 35 U.S.C. § 103(a) rejections of claims 6, 7 and 10 is respectfully solicited, as is the allowance of these claims.

**CONCLUSION**

It is respectfully submitted that each of claims 1, 2, 4-10, 18, and 19 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



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